

REMARKS

The abstract and claims have been amended so as to take care of the formal matters kindly pointed out by the Examiner.

Reconsideration is respectfully requested, for the refusal to consider DE 489529. This reference was cited in the Information Disclosure Statement filed April 13, 2005, which was accompanied by a copy of the International Search Report, wherein the pertinence of the German reference was identified by the letter "A". According to MPEP 609A(3), this is adequate. A marked copy of that page of the MPEP is attached hereto for the Examiner's convenience.

Reconsideration is respectfully requested, for the rejection of the claims as anticipated by BOYCE or FRENCH et al., or as unpatentable over BOYCE.

There are attached hereto two drawings showing the prior art (SKIZZ 1) and the present invention (SKIZZ 2).

"Skizze 1" with a banner with no distance means (like discs or rollers) on the banner rod (Bannerstange) shows that the banner itself is lying directly on the ground (Bannerstange liegt am Boden). In view of the direction of movement (STR Startrichtung) and the direction of air moving (LLuftstromung) and in view of the very little distance between the ground and the lower side of the banner an acceleration of air moving below the banner is created which results in an underpressure due to the Bernoulli effect (Venturieffekt). That underpressure sucks

the banner to the ground, which, due to the friction created, inhibits the starting of the airplane with the banner.

In contrast thereto, the inventive design as shown in "Skizze 2" with distance means (mit Abstandhalter (Rollen etc.)) the banner rod has a distance from the ground which results that on the underside of the banner, namely between the ground and the banner there is a normal flow of air which is in speed equal to the flow of air on the upperside of the banner such that no Bernoulli effect and consequently no underpressure is created that would result in that the banner clinging to the ground.

These explanations show that problems encountered with prior art banners of the type preceding the invention have problems when an airplane tries to start having the banner fixed to it because the banner will stick to the ground whereas in the invention as claimed, no such problems occur.

None of the prior art cited show that advantageous design of a banner nor do any of the references indicate that the advantageous effect (as explained above) would be obtained.

BOYCE discloses a banner to be held in a vertical position and fixed to a rod at its leading edge and to a parachute at its trailing edge. No means assist in starting of the banner is disclosed. It should be emphasized that element 15 is a wheel with a handle 16 for rolling the banner onto or off from the roller 3. In addition, 18 is a washer intended to avoid problems when rolling up the banner (column 5, lines 34-39).

Thus, the interpretation of BOYCE in item 6 of the Official Action is not supported by the disclosure of BOYCE.

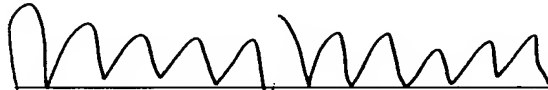
The patent to FRENCH et al. discloses a cart to be connected to a bicycle which cart of course has two wheels. No reference to a banner can be seen. We would emphasize that the interpretation of Figure 2 of FRENCH as given in item 7 of the Official Action was made in knowledge of the invention and is *ex post facto*. The rear member (back rest) of the cart is not a banner and the rod that is part of the frame of the cart is not a banner-rod.

As the claims as amended are believed clearly to bring out the novel and unobvious subject matter of the present invention for the reasons pointed out above, it is believed that they are all patentable, and reconsideration and allowance of the application as a whole is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

A handwritten signature in black ink, appearing to read 'Robert J. Patch', written over a horizontal line.

Robert J. Patch, Reg. No. 17,355  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

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**APPENDIX:**

The Appendix includes the following items:

- amended Abstract of the Disclosure
- marked copy of page MPEP 609A(3)
- two drawings showing the prior art (SKIZZE 1) and the present invention (SKIZZE 2)

listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted).).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

### **A (3) Concise Explanation of Relevance for Non-English Language Information**

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise

explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) ("[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.").

In *Semiconductor Energy Laboratory*, patentee during prosecution submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less mate-